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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,130	01/09/2001	Benjamin Englander	P/1123-53	6441

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EXAMINER	
NGUYEN, THONG Q	

ART UNIT	PAPER NUMBER
2872	

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/757,130	ENGLANDER, BENJAMIN	
	Examiner	Art Unit	
	Thong Q. Nguyen	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/22/06 has been entered.

Response to the Communication of 2/22/06

2. The present Office action is made in response to the Response filed on 2/22/06. It is noted that in the Response of 2/22/06, applicant has filed a list of claims contained claims 1-8 and provided arguments regarding to the rejections of the claims over the art as set forth in the Office action of 6/14/04. It is also noted that applicant has filed a Declaration under 37 CFR 1.132 with the Response.

3. Regarding to the list of claims as provided in the Response of 2/22/06, it is noted that the claim 1 with the status indicator thereof "(previously presented)" contains an error. In particular, on line 14 of the claim, the terms "no more" were deleted from the claim as provided in the amendment of 3/8/04; however, such terms are shown again in the claim. The examiner assumed that the mentioned terms are not in the claim for the reason that the claim contains the term "less" (line 14) which was added in lieu of the terms "no more" as provided in the amendment of 3/8/04.

In the spirit of co-operation, the claims as listed in the response of 2/22/06 are examined in this Office action; however, applicant should amend the claim 1 by deleting the terms "no more" appeared on line 14 of the claim in response to this Office action.

Claim Objections

4. Claims 1 and 7 are objected to because of the following informalities. Appropriate correction is required.

a) In claim 1: on line 2, "direction" should be changed to –directions--; and

b) In claim 7: on line 2, the feature "the minor axis of the mirror surface" lacks a proper antecedent basis. Applicant should note that the claim 6 (see line 2), not claim 1, provides an antecedent basis for the feature related to the minor axis of the mirror surface. Should the claim 7 be amended to depend upon claim 6?

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-6 and 8, are rejected under 35 U.S.C. 103(a) as being unpatentable over Stout (U.S. Patent No. 4,822,157, of record) in view of Falge (U.S. Patent No. 1,768,354, of record).

Stout discloses a mirror assembly for use with a school bus wherein the mirror assembly is attached to a front fender of the bus for the purpose of providing the driver of the bus visual access to the area in front of the school bus as well as to the sides of the bus. See abstract and column 2 (lines 29-34). The mirror assembly as stated at column 2 and shown in figures 1-3 comprises a mirror

element (26) having an oval ellipsoidal shape and configured as a convex, generally dome shaped and contiguous mirror surface with its contoured outer surface facing in a direction of the driver. The mirror assembly is secured to a mirror pole (20) via a securing means (48, 50, 52). The mirror pole (20) in turn is inherently secured to the front fender of the school bus. See column 3 and fig. 1. As such, the mirror assembly provided by Stout meets all of the limitations of the device as claimed except a portion of the mirror element being treated for reducing glare.

The treatment on a portion of the mirror element, in particular, on an upper portion of the mirror, for the purpose of reducing glare is known to one skilled in the art as can be seen in the optical system provided by Falge. In particular, Falge discloses a mirror system having a mirror surface wherein the upper portion of the mirror is treated to reduce glare without rendering the treated portion opaque as to be non-reflective. See Falge, pages 1-2 and figs 1 and 8, for example.

Regarding to the dimension/size of the portion being treated (36) for reducing glare, in the embodiment of figure 8, the treated portion has an area of one-half of the upper one-third of the mirror (see page 2, column 4, lines 93-101). See also **In re Wertheim**, 541 F. 2d 257, 191 USPQ 90 (CCPA 1976), "the disclosure in the prior art of any value within a claimed range is an anticipation of that range." See also, **Titanium Metals Corporation of America**, 227 USPQ 773 (Fed. Cir. 1985), **In re Petering**, 301 F. 2d 676, 133 USPQ 275 (CCPA 1962). It

is noted that the treated portion is located in spaced relation to and not in contact with any portion of the uppermost peripheral edge of the mirror surface along the vertical direction of the mirror surface.

Regarding to the feature that the treated portion is located in the area defined from an uppermost position on the contoured mirror surface and the so-called a "curved line which begins and ends on the peripheral edge and which curves relative to a straight line which bisects the mirror surface", such a feature is readable from the mirror having treated portion provided by Falge. In other words, one skilled in the art will recognize that (s)he can drawn any curved line in the area defined between the bottom edge of the treated portion (36) and a straight line which bisects the mirror surface. Applicant should note that such a curved line as recited is merely that of an imaginary line, not a physical line or resulted from a mechanical construction/structure of the mirror surface.

With regard to the feature concerning the formation of the coating band as recited in claim 4, such a feature is directed to a method step and thus is not given a patentable weight. See **In re Dike**, 157 USPQ 581 (CCPA 1968).

Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the mirror assembly provided by Stout by making a portion of the upper one-third of the mirror as a treated portion for reducing glare.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stout in view of Falge as applied to claim1 above with or without Malifaud (U.S. Patent No. 3,199,114, of record).

The combined product as provided by Stout and Falge as described above meets all of the features recited in present claim 7 except the treated portion is located on one side relative to the minor axis of the mirror surface. However, such an arrangement of a treated portion with respect to the area of an optical element having a substantially oval shape as claimed is merely that of a preferred embodiment and no criticality has been disclosed. The support for this conclusion is found in the present specification in which applicant has taught that the treated portion is extended on both side of the minor surface as can be seen in the embodiment described at pages 4-5 and illustrated in present figure 2A-2C. Furthermore, the use of an anti-glare portion which is located on one side of an optical element having an oval shape and on a side relative to a minor axis of the optical element is known to one skilled in the art as can be seen in the anti-glare system provided by Malifaud. See column 5 and fig. 5. Thus, absent any showing of criticality, it would have been obvious to one skilled in the art at the time the invention was made to utilize the teaching, i.e., use the antiglare portion on just one side of an optical element as suggested by Malifaud in the combined product provided by Stout and Falge by using a portion on just one side of the minor axis of a mirror surface which portion is necessary to the driver's field of view as a treated portion for reducing glare and simultaneously reducing the manufacture cost.

Response to Arguments

8. Applicant's arguments filed on 2/22/06, pages 5-6, have been fully considered but they are not persuasive for the following reasons.

Applicant argues that the combined art does not disclose the invention as claimed, see Response, pages 5-6. In particular, applicant has argued that the device as provided by Falge comprises two mirrors while the claims of the present application is directed to a mirror element that is treated to reduce glare without rendering the treated surface opaque as to be non-reflective. The examiner respectfully disagrees with the applicant for the following reasons.

First, the examiner does not agree with the applicant's opinion about the structure of the mirror assembly provided by Falge. As stated in column 3 and in the claim 1, for instance, the mirror of Falge is "A one piece uniplanar mirror provided with an upper zone of low reflecting efficiency and a lower zone of high reflecting efficiency".

Second, it is suggested that applicant is respectfully invited to review the present claims. The present claims have not recited any specific limitations/features related to the structure of the mirror having a treated portion. The claim 1, on lines 13-20, just recites that a portion of the mirror being treated to reduce glare without rending the treated surface opaque as to be non-reflective. There is not any specific limitations/features to the structural of the treated portion as well as how the treated portion being formed. The terms "being treated" used in the claim does not provide any structural feature. In the mirror provided by Falge, the

mirror has a portion being treated to reduce glare and the treated portion of the mirror has an opaque feature without rendering the treated portion opaque as to be non-reflective. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

b) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., applicant's mirror provides a single image of the space in front and alongside the bus, both at ground level and higher up" (Response, page 6)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

c) Regarding to the rejection of the dependent claims, it is noted that the applicant has not provided any specific arguments except a reference that the art used in the rejection does not disclose the feature recited in the present claim 1, thus the dependent claims are still rejected for the same reasons as set forth in the previous Office action and repeated in this Office action.

9. The Declaration under 37 CFR 1.132 filed on 2/22/06 is insufficient to overcome the rejection of claims 1-8 based upon 35 USC 103(a) over the combination of art provided by Stout and Falge as set forth in the last Office action because the

Declaration fails to provide sufficient facts to show the unobviousness of the claimed subject matter.

It is noted that the Declaration just provide a list of the features being claimed in the present application, see Declaration, elements 2-5, and these features are clearly disclosed in the combination of art provided by Stout and Falge. See the rejection to the claims as provided above.

Regarding to the element 6, i.e., "The mirror provides a single...less bright", such a feature is not in the claim.

Regarding to the element 7, i.e., "As an engineer...unobvious", such a bare statement without any evident supports/facts is not sufficient to overcome the rejection, and thus is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Conclusion

10. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thong Q Nguyen
Primary Examiner
Art Unit 2872

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